REMARKS

By way of summary, Claims 1-10, 21, 29-35, and 41-71 were pending in the present application. In the present amendment, Applicant cancels Claims 34, 35, and 41-59 without prejudice or disclaimer, and Applicant reserves the right to pursue such claims in a continuation or divisional of this application. Additionally, Claims 21 and 29 are amended in the present amendment. Thus, Claims 1-10, 21, 29-33, and 60-71 are now pending in this application.

The Office Action dated January 12, 2005, rejected Claims 1-10, 21, 29-34, and 60-71 under 35 U.S.C. § 102(b). By way of the foregoing amendments and the following comments, it is believed that Claims 1-10, 21, 29-33, and 60-71 are patentably distinguished over the cited reference, and Applicant respectfully requests allowance of the pending claims.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

The Office Action rejected the pending claims under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,705,038, issued to Sjostrom et al., (the Sjostrom patent). Applicant respectfully traverses this rejection because the Sjostrom patent fails to identically teach every element of the rejected claims. See M.P.E.P. § 2131 (stating that in order to anticipate a claim, a prior art reference must identically teach every element of the claim).

The Sjostrom Patent

Sjostrom discloses an arthroscopic surgical system for operating a set of different surgical devices each having different limits on speed and torque during operation. Col. 1, lines 27-29, 65, 68. The surgical system has a handpiece that is adapted to receive a proximal portion of each of the surgical devices. Col 1, lines 30-32. On the proximal portion of each surgical device is provided a magnet or magnets that are adapted to produce a magnetic field different from that of other surgical devices of the set. Col. 2, lines 2-4. The magnets are arranged in predetermined respective patterns, Col. 3, lines 37-38, to actuate sensors consisting of end operated mini-reed switches located on the handpiece. Col. 3, lines 31-32, 36-37. The predetermined magnet patterns actuate the switches on the handpiece to identify which surgical device is being used, and the preselected limits regarding the speed range and torque limits are thereby established for the system. Col. 3, lines 37-44. Sjostrom teaches that the system permits recognition of one of

four possibilities: either no device is connected to the handpiece or one of three rotary tips is connected. Col. 5, lines 24-27.

Independent Claims 1 and 60

The Office Action states that "Sjostrom et al. clearly teaches a sensor on the device in electrical communication with an indicator." Office Action dated January 12, 2005, page 3. However, in contrast to the above-description of what is disclosed in Sjostrom, Claim 1 recites, among other things, "a sensor on the device in electrical communication with an indicator, *for indicating resistance to rotation of either the rotatable element or rotatable cutter.*" Even if the mini-reed switches of Sjostrom are interpreted to be the sensor, which they should not be, and the magnetic fields of Sjostrom are interpreted to be the indicators, which they should not be, the Sjostrom system does not teach or suggest that the mini-reed switches and the magnetic fields indicate resistance to rotation of either the rotatable element or rotatable cutter.

In contrast, Sjostrom teaches that the magnetic fields on the rotary tips actuate the mini-reed switches to communicate to the system which, if any, rotary tip is positioned on the handpiece. Therefore, it is respectfully submitted that Sjostrom does not teach or suggest all the limitations of Claim 1, and withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Claim 60 recites limitations that are similar to Claim 1, and it is respectfully submitted that Sjostrom does not teach or suggest all the limitations of Claim 60, and withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Independent Claim 21

The Office Action also states, regarding Claim 21, that "the cross-sectional area of the aspiration lumen is inherently capable of being at least about 35% of the cross-sectional area of the tubular body." Office Action, page 2. However, Sjostrom is silent as to the relative size of the alleged aspiration lumen and tubular body. The only explicit indication Sjostrom provides for the size of an aspiration channel is found in Figure 2a, which illustrates a drain tube 40 within a portion of the handpiece. However, this drain tube 40 appears to Applicant to comprise no more than 15% of that which surrounds the drain tube 40.

The Office Action's conclusory remarks that the aspiration lumen is *inherently capable* of such a construction as recited in Claim 21 relies on no specific teaching or suggestion in

Sjostrom and fails to consider the significant and innovative reconstruction that would be required to modify the Sjostrom surgical device in order to meet the limitations of Claim 21. As described at page 24, line 9 of Applicant's specification, according to one embodiment of Applicant's invention:

> [T]he cross-sectional area of the lumen 20 is preferably maximized as a percentage of the outside diameter of the tubular body 12. This permits an optimization of lumen cross-sectional area which maintains a minimal outside diameter for tubular body 12, while at the same time permitting an acceptable flow rate of material through the aspiration lumen 20, with minimal likelihood of clogging or binding which would interrupt the procedure. Cross-sectional area of the aspiration lumen 20 thus may be optimized if the drive tube 24 is constructed to have relatively high torque transmission per unit wall thickness such as in the constructions described above.

Applicant respectfully submits that Sjostrom does not teach or suggest all the limitations of Claim 21, and withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Independent Claim 29

Applicant respectfully submits that Sjostrom does not teach all the limitations of amended Claim 29. For example, Claim 29 as amended recites, among other things, "an axially extending annular aspiration channel between the rotatable element and the tubular body." Sjostrom fails to teach or suggest an annular aspiration channel as recited in Claim 29, and thus, withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Independent Claims 65 and 68

Applicant respectfully submits that Sjostrom does not teach all the limitations of Claims 65 and 68. For example, Claim 65 recites, among other things, that the connecting hub couples "the tubular body to the control such that the tubular body may rotate relative to the control." Sjostrom fails to teach or suggest any relative rotation between the handpiece and a tubular body that may attach thereto. In fact, at col. 4, lines 3-11 and lines 20-31, Sjostrom teaches providing key slots to mate the rotating tip with the desired surgical device, and the surgical device with the handpiece. These key slots prevent relative rotation. Further, it would be undesirable for Sjostrom's surgical device to permit rotation of such a tubular body because rotation of the surgical device with the handle would disrupt the magnetic field that identifies to the system which surgical device is being used.

Additionally, Claim 68 recites, among other things, that the cutter is "capable of axial displacement relative to the control." Sjostrom fails to contemplate whether the cutter is capable of axial displacement relative to the control. The cited reference provides no disclosure on the relative movement or capacity of such movement between a control and the cutter. In fact, at col. 4, lines 11-12 and 33-35, Sjostrom contemplates the use of suction to hold the rotating tip/surgical device and the surgical device/handpiece together, teaching away from allowing these components to be axially displaced relative to each other.

Thus, Applicant respectfully submits that Sjostrom fails to teach at least the foregoing limitation recited in Claims 65 and 68, and therefore withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Dependent Claims 2-10, 30-33, 61-64, 66-67, and 69-71

Claims 2-10, 30-33, 61-64, 66-67, and 69-71 which depend from Claims 1, 29, 60, 65, and 68, respectively, are believed to be patentable for the same reasons articulated above with respect to Claims 1, 29, 60, 65, and 68, and because of the additional unique features recited therein. Accordingly, it is respectfully submitted that Sjostrom does not teach or suggest all the limitations of these claims or the independent claims from which these claims depend, and withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

CONCLUSION

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Applicant's undersigned attorney of record hereby formally requests a telephone interview with the Examiner. The Applicant's attorney can be reached at (949) 760-0404.

In addition, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9-12-05

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